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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
DANIEL A. GATELY  
Serial No. 09/016,641  
Filed January 30, 1998  
FOR: SILYLATED AND N-SILYLATED  
COMPOUND SYNTHESIS

:  
: Art Unit 1621  
:  
:  
: Examiner: J. Vollano  
:

SUPPLEMENT TO "RENEWED PETITION UNDER  
37 C.F.R. §1.144" FILED MARCH 10, 2000

Honorable Commissioner of  
Patents and Trademarks  
Washington, D. C. 20231

Sir:

Status of "Renewed Petition"

Counsel understands that the "Renewed Petition" has been or will "be sent forward" by Group Art Unit 1621 (Examiner J. Vollano; see April 24, 2000 "Interview Summary"). Informed disposition of the "Renewed Petition" is deemed to require concurrent consideration of this "Supplement".

This Supplement addresses facts first known to counsel as a result of occurrences during the April 14 to April 24, 2000 time period. The positions stated in the Renewed Petition are maintained and relied upon but not reiterated in this Supplement.

### Issues

The issues are:

1. Whether "restriction within claims" is barred when 35 U.S.C. §121 is correctly construed together with 35 U.S.C. §103(a) and 35 U.S.C. §112.

2. Whether 37 C.F.R. §1.142 and M.P.E.P. §803.02 are invalid if and as construed and applied to permit restriction within a claim.

Ample reasons why each of these issues should be answered "yes" are set forth in each of the original and renewed petitions. The subsequent petition decisions do not meaningfully address these reasons. This Supplement presents an additional and dispositive reason, first made known to counsel during the April 14 to April 24, 2000 time period, for affirmative answers to each of questions 1 and 2.

### The Additional Reason

The Examiner interviews and related documents indicate that:

1. The Examiner and apparently other examiners have encountered serious problems in connection with this application and others in the preparation, within the limited time allowed by Patent Office unpublished regulations (understood to be 90 minutes), of a "complete" action as required by 37 C.F.R. §1.104(b).

2. The aforesaid problem is acute in the context of applications which include many claims set forth in a large number of pages and of applications which contain claims directed to Markush groups having a large number of members.

3. To solve the problem, the Examiner in this case (in what may be uniform practice in Art Unit 1621) resorted to a requirement for restriction within claims postulated on a strained argument that "independent and distinct inventions are claimed" (Rule 1.142) within the claims presented. It is that restriction requirement which resulted in all of the petition proceedings in this case.

#### Applicant's Position

Applicant's position is that the rules and regulations as applied to preclude compliance with 35 U.S.C. §103(a) and §112 are not valid and should be deleted or amended. In particular, unpublished time limits on examination which preclude compliance with 37 C.F.R. §1.104 are invalid. Further, 37 C.F.R. §1.142 and M.P.E.P. §803.02 as construed and applied in this application to permit "restriction within claims" and thus prejudice discharge of the Examiner's and Patent Office's duty under 35 U.S.C. §§103(a) and 112 and 37 C.F.R. §1.104 are not valid.

The ensuing Fact Statement explains these issues in the context of this application. Because the validity or invalidity

of a "restriction within claims" practice is a broad issue not restricted to this application, a reasoned disposition of the Renewed Petition is in order.

#### Fact Statement

The "Renewed Petition" was timely filed on March 20, 2000. On April 14, 2000 (Friday), the Examiner called counsel to discuss "recombining" some of the claims subject to the disputed "restriction within claims" requirement, which is the subject of the Renewed Petition. The Examiner stated, in substance, that the Renewed Petition was due to be "sent forward" by Monday, April 17, 2000 and that if "sent forward", disposition of the petition would be long delayed, perhaps by more than one year. The Examiner suggested withdrawal of the Renewed Petition if agreement was reached to recombine some of the claims involved in the restriction requirement. Because the matter was difficult to resolve by telephone, it was agreed to have a personal interview on Monday, April 17, 2000, which was done.

At the outset of the interview, counsel stated that he would not agree to restriction within a claim. The Examiner, in response, summarized the "problem" above set forth which, it is understood, motivated a "restriction within a claim" practice. The Examiner again mentioned the delay which would result if the Petition were "sent forward" to the supervisory authority for

disposition. The Examiner did not, however, want to establish a precedent which might preclude restriction within a claim. The interview proceeded from that point.

The result of the interview is correctly set forth in the April 17, 2000 "Interview Summary" as follows:

The examiner has agreed to rejoin all non-nitrogen claims both process + compounds if applicant cancels all nitrogen directed claims. Applicant proposes withdrawing petition for speedy prosecution.<sup>1</sup> The amendment if presented must filed timely. [Emphasis added.]

At 12:30 p.m. on Wednesday, April 19, 2000, applicant transmitted by fax to the Examiner a "Second 37 C.F.R. §1.116 Response" (Exhibit A hereof). The Examiner, pursuant to her request, was concurrently advised by telephone that the fax had been sent. Through inadvertence, the "Second Response" did not purport to cancel "all nitrogen directed claims", as agreed at the April 17, 2000 interview, but instead purported incorrectly to cancel all non-nitrogen claims, i.e., claims subject to the proposed rejoinder. Notably, this error is clearly set forth on the first page of the Second Response (which the Examiner received shortly after transmittal on April 19, 2000 upon

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<sup>1</sup> Applicant's motivation for a proposed withdrawal of the petition was not limited to "speedy prosecution", but also included a desire to accommodate the Examiner's wish to avoid precedent which would compromise or preclude restriction within claims.

telephone notification that the fax had been sent—all pursuant to her request), which states:

This second 37 C.F.R. §1.116 Response is filed to implement the agreement noted by the April 17, 2000 "Interview Summary".

I.

It is the intent of this amendment to cancel all non-nitrogen claims, both process and compounds.... [page 1]

Appropriately because of this error, the Second Response was not entered. A "Third Response" which does cancel "all nitrogen directed claims" was faxed to the Examiner on Monday, May 1, 2000.

The "Renewed Petition" is not withdrawn in view of "The Additional Reason" set forth above.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Any fee due may be charged to Deposit Account 09-0948.



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Dated: May 1, 2000

Fax to Art Unit - 703/308-4556